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| 09/942,364 | 08/29/2001 | Eric Ronald Morley | 2157 | 8898 |

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| EXAMINER | |
|---|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 3639 | |

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/942,364 | MORLEY ET AL. | |
| | Examiner | Art Unit | |
| | Fadey S. Jabr | 3639 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/22/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims **1-20** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. A claim limited to a machine or manufacture which has practical application in the technological arts is statutory. In most cases, a claim to a specific machine or manufacture will have practical application in the technological arts. See MPEP 2106, 2100-14 (quoting *In re Alappat,* 33 F.3d at 1544, 31 USQ2d at 1557). Additionally, for subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970).

In the present case, claim 1, 12, and 20 only recite an abstract idea. The recited steps of merely evaluating and comparing a carrier based upon their past performance does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select a carrier to transport goods.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and

tangible result". See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2dat 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement

rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claimed invention evaluates and compares a carrier based on historical data (i.e., repeatable) used in determining and selecting the best carrier (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1, 12, and 20 are deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims **12-20** rejected under 35 U.S.C. 102(b) as being anticipated by Riggs et al., U.S. Patent No. 6,915,268 B2.

As per **Claim 12**, Riggs et al. discloses a method of selecting a carrier from a group of carriers to make a trip to transport goods from a first location to a second location during a given time period, comprising the steps of:

- a) evaluating each carrier's capacity to make trips between said first and second locations during a given time period (Col. 9, lines 11-16, 51-53);

- b) comparing the carriers based on their capacity to make a trip from the first location to the second location during the given time period (Col. 8, lines 56-60; Col. 9, lines 51-53); and

- c) selecting a carrier (Col. 18, lines 11-13).

As per **Claim 13**, Riggs et al. discloses a method of selecting a carrier from a group of carriers to transport goods from a first location to a second location further comprising the step of:

- d) evaluating each carrier's past performance on trips between said first and second locations (Col. 6, lines 7-10; Col. 12, lines 8-11); and

- e) comparing the carriers based on their past performances on trips from the first location to the second location and on their capacity to make trips between said first and second locations during a given time period (Col. 8, lines 56-60; Col. 9, lines 11-16, 55-55).

As per **Claim 14**, Riggs et al. discloses a method of selecting a carrier from a group of carriers to transport goods from a first location to a second location further comprising the step of:

- d) evaluating the cost for each carrier to make the trip (Col. 8, lines 54-60);

- e) comparing the carriers based on their capacity for trips from the first location to the second location during a given time period and on their cost to make trips between said first and second locations during a given time period (Col. 8, lines 54-60; Col. 9, lines 3-5, 11-16, 51-55).

As per **Claim 15**, Riggs et al. discloses a method of selecting a carrier from a group of carriers to transport goods from a first location to a second location further comprising the step of:

- e) evaluating the cost for each carrier to make the trip (Col. 8, lines 54-60);
- f) comparing the carriers based on their past performances on trips from the first location to the second location, on their capacity to make trips between said first and second locations during a given time period, and on the cost for each carrier to make the trip (Col. 8, lines 56-60; Col. 9, lines 3-5, 11-16, 51-55).

As per **Claim 16**, Riggs et al. discloses a method further comprising the step of:

- d) after a carrier is selected to transport goods from a first location to a second location, adjusting the carrier's capacity data to reflect that load taken (Col. 9, lines 61-67; Col. 10, lines 10-11; Col. 18, lines 11-13).

As per **Claim 17**, Riggs et al. discloses a method

- e) storing carrier capacity data based on contractual requirements and limits in a database in association with the carrier (Col. 6, lines 30-37);
- f) updating said capacity data upon carrier's acceptance of a trip (Col. 9, lines 61-67; Col. 10, lines 10-11).

As per **Claim 18**, Riggs et al. discloses a method wherein the contractual requirements and limits are for a specified time period, and further comprising the step of:

- g) resetting the stored carrier capacity data upon completion of a specified time period (Col. 9, lines 61-67; Col. 10, lines 10-11).

As per **Claim 19**, Riggs et al. discloses a method further comprising the steps of:

- d) determining the mode of each load for a specified trip between the first location and the second location (Col. 9, lines 55-58; Col. 13, lines 45-53); and
- e) comparing the carriers based on their capacity on trips from the first location to the second location during a given time period and on their mode to make a trip between said first and second locations during a given time period (Col. 8, lines 54-60; Col. 9, lines 11-16, 51-55).

As per **Claim 20**, Riggs et al. discloses a method of selecting a carrier from a group of carriers to transport a shipment of goods from a first location to a second location, comprising the steps of:

- a) for each carrier, identifying the maximum number of shipments allowed to that carrier over a given period of time (Col. 14,lines 22-30);
- b) comparing the number of shipments carried by each carrier during the given period to the maximum number allowed to that carrier (Col. 14, lines 22-30);
- c) for each carrier that has not exceeded the allowed shipment number during said period (Col. 14, lines 18-30):
    - o (i) evaluating each carrier's past performance on trips from the first location to the second location (Col. 6, lines 7-16, Col. 9, lines 8-11);
    - o ii) evaluating each carrier's capacity (Col. 9, lines 11-16, 55-57);

- iii) evaluating the cost for each carrier to make the trip (Col. 8, lines 54-60);
- iv) comparing the carriers; v) selecting a carrier (Col. 18, lines 11-13); and
- vi) adjusting the capacity data of the selected carrier for the given period

(Col. 9, lines 61-67; Col. 13, lines 10-11).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims **1-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Riggs et al., U.S. Patent No. 6,915,268 B2 in view of Paul, U.S. Patent No. 6,356,838 B1.

As per **Claim 1**, Riggs et al. discloses a method of selecting a carrier from a group of carriers to make a trip to transport goods from a first location to a second location, comprising the steps of:

- a) evaluating each carrier's past performance (Col. 6, lines 7-16; Col. 12, lines 8-11);
- b) comparing the carriers based on their past performances on trips from the first location to the second location (Col. 8, lines 56-60); and
- c) selecting a carrier (Col. 18, lines 11-13).

Riggs et al. fails to disclose a method for evaluating each carrier's past performance on previously-made trips from the first location to the second location. However, Paul discloses evaluating trips based on a carrier's performance from one location to another (Col. 10, lines 17-35). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Riggs et al. and provide the step of evaluating a carrier based on their past performance from one location to another. Paul provides motivation by revealing that the results of the evaluation could be used to determine the most-efficient route for the carrier (Col. 10,lines 24-27).

As per **Claim 2**, Riggs et al. further discloses a method of selecting a carrier from a group of carriers to transport goods from a first location to a second location further comprising the step of:

- d) evaluating each carrier's capacity to make trips between said first and second locations during a given time period (Col. 9, lines 11-16, 51-55); and
- e) comparing the carriers based on their past performances on trips from the first location to the second location and on their capacity to make trips between said first and second locations during a given time period Col. 8, lines 56-60l Col. 9, lines 11-16, 51-55).

As per **Claim 3**, Riggs et al. further discloses a method of selecting a carrier from a group of carriers to transport goods from a first location to a second location further comprising the step of:

- d) evaluating the cost for each carrier to make the trip (Col. 8, lines 54-60);

- e) comparing the carriers based on their past performances on trips from the first location to the second location and on their cost to make trips between said first and second locations during a given time period (Col. 8, lines 54-60; Col. 9, lines 3-5, 11-16, 51-55).

As per **Claim 4**, Riggs et al. further discloses a method of selecting a carrier from a group of carriers to transport goods from a first location to a second location further comprising the step of:

- e) evaluating the cost for each carrier to make the trip (Col. 8, lines 54-60);
- f) comparing the carriers based on their past performances on trips from the first location to the second location, on their capacity to make trips between said first and second locations during a given time period, and on the cost for each carrier to make the trip (Col. 8,lines 56-60; Col. 9,lines 3-5, 11-16, 51-55).

As per **Claim 5**, Riggs et al. further discloses a method according to claim 1 further comprising the step of:

- d) after a carrier is selected to transport goods from a first location to a second location, adjusting the carrier's capacity data to reflect that load taken (Col. 9, lines 61-67; Col. 10, lines 10-11).

As per **Claim 6**, Riggs et al. further discloses a method further comprising the steps of:

- e) storing carrier capacity data based on contractual requirements and limits in a database in association with the carrier (Col. Col. 6, lines 30-37);

- f) updating said capacity data upon carrier's acceptance of a trip

(Col. 9, lines 61-67; Col. 10, lines 10-11).

As per **Claim 7**, Riggs et al. further discloses a method wherein the contractual requirements and limits are for a specified time period, and further comprising the step of:

- g) resetting the stored carrier capacity data upon completion of a specified time period (Col. 9, lines 61-67; Col. 10, lines 10-11).

As per **Claim 8**, Riggs et al. further discloses a method further comprising the steps of:

- d) determining the mode of each load for a specified trip between the first location and the second location (Col. 9, lines 55-58; Col. 13, lines 45-53); and

- e) comparing the carriers based on their past performances on trips from the first location to the second location and on mode to make a trip between said first and second locations during a given time period

(Col. 8, lines 56-60; Col. 9, lines 55-58; Col. 13, lines 45-53).

8. Claims **9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Riggs et al., U.S. Patent No. 6,915,268 B2 in view of Paul, U.S. Patent No. 6,356,838 B1 as applied to claim 1 above, and further in view of Federal Express Freight (FedEx Freight) "FedEx Freight Press Release", hereinafter referred to as FedEx Freight.

As per **Claims 9 and 11**, Riggs et al. discloses all of the limitations of claim 1. Riggs et al. fails to disclose a method wherein said past performance is evaluated based on on-time percentage. However, FedEx Freight discloses a method for evaluating carriers based on on-time performance (FedEx Freight Para. 5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Riggs et al. and provide the step of evaluating a carrier based on on-time percentage as disclosed by FedEx Freight because it would be obvious to want to have your package delivered when you paid for it to be delivered.

As per **Claims 10**, Riggs et al. discloses all of the limitations of claim 1. Riggs et al. fails to disclose a method wherein said past performance is evaluated based on claims ratio.. However, FedEx Freight discloses a method for evaluating carriers based on claims ratio (FedEx Freight Para. 5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Riggs et al. and provide the step of evaluating a carrier based on claims ratio as disclosed by FedEx Freight because it would be obvious to want to have your package delivered without being damaged or even lost.

***Conclusion***

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references

in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fadey S Jabr
Examiner
Art Unit 3639

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JOHN W. HAYES
PRIMARY EXAMINER